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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,495	02/09/2001	Yuichi Kawanishi	1344.1055 (JDH)	5533
21171 7590 10/15/2003 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER MORAN, MARJORIE A	
			ART UNIT 1631	PAPER NUMBER

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/779,495

Applicant(s)

KAWANISHI ET AL.

Examiner

Marjorie A. Moran

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): the 2nd rejection under 35 USC 112.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 2-9.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance because: applicant has not overcome, by argument or amendment, the rejection with regard to a means with an operator "interactively designating", therefore this rejection is maintained. With regard to claim 8, applicant's attention is drawn to line 3 which recites inputting a piece of gene arrangement information. The claim does not recite where or into what database the gene arrangement information is to be input. Claim 8 then recites extracting a motif from the gene arrangement information then recites retrieving (a separate step from extracting) gene arrangement information comprising the extracted motif from a "gene arrangement information database". The last line of the claim recites adding the retrieved information to the INPUT gene arrangement information. The claim does NOT recite adding retrieved information to the database recited in the retrieving step. The claim therefore may be interpreted to embody two separate databases of gene arrangement (i.e. sequence) information. The INPUT database is used to find/identify a motif. The identified motif may then be used to retrieve sequences from a separate database which comprise that motif. The sequences extracted are then added to the FIRST database. This is the method taught by ATTWOOD. He identifies motifs and uses the identified motifs to retrieve sequences from a larger database. He then adds the retrieved sequences to the STARTING database (his motif database). In response to applicant's arguments that claim 8 recites "reutilizing" a motif, it is noted that the claims are not so limited. If applicant intends the input information to be added to the SAME DATABASE from which a motif is retrieve, then the examiner recommends amending the claims to clearly and specifically set forth applicant's intended limitations. In response to arguments regarding KAWANISHI and MARR wherein applicant argues that KAWANISHI does not teach "interactively" designating a motif extraction range and MARR "merely discloses" the concept of interactive command input, it is noted that the rejection is made over a combination of references wherein KAWANISHI is relied upon for teaching setting a motif extraction range and MARR is relied upon for his teaching for interactive input. For the reasons set forth above and previously set forth, the examiner maintains that ATTWOOD, KAWANISHI and MARR teach all of the claimed limitations and therefore make obvious the claimed method, therefore the rejection under 35 USC 103 is maintained. Applicant's arguments with regard to "an object to be clarified" are confusing to the examiner as the claims do not recite an "object". Applicant previously defined "clarified" to mean "sequenced"; however, the claims do not recite sequencing either. Applicant's arguments with regard to "means" as applied to claims 8 and 9 are not convincing as claims 8 and 9 do not recite any "means" .

MARJORIE MORAN  
PATENT EXAMINER

